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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/820,292 | 03/27/2001 | Daniel F. Williams | PSTM0042/MRK | 1726 |
| 29524 | 7590 | 03/25/2005 | EXAMINER | |
| KHORSANDI PATENT LAW GROUP, A.L.C. 140 S. LAKE., SUITE 312 PASADENA, CA 91101-4710 | | | WEBB, JAMISUE A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3629 | |

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,292

Applicant(s)

WILLIAMS ET AL.

Examiner

Jamisue A. Webb

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-169 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-169 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-27, 39-65, 77-103 and 115-141, drawn to a computer system and method which receives and processes merchandise return requests according to policy rules, classified in class 705, subclass 1.
 - II. Claims 28-33, 66-71, 104-109 and 142-147, drawn to a computer system and method which saves a three dimensional response matrix, classified in Class 705, subclass 1.
 - III. Claims 34-38, 72-76, 110-114 and 148-152, drawn to a return computer system with displays a set of return questions and receives answers, and then generates a set of instructions, classified in class 705, subclass 1.
 - IV. Claims 153 and 155, drawn to a computer system with receives a request to rate a shipment, classified in class 705, subclass 1.
 - V. Claim 154, and 156-159, drawn to a system, which receives a request from a second computer system for a return and calculates a plurality of rates, classified in class 705, subclass 1.
 - VI. Claims 160-163 and 167-169, drawn to a method of preparing a shipping label, classified in class 705, subclass 1.
 - VII. Claim 164, drawn to a computer system programmed to designate a status of a return record, classified in class 705, subclass 1.

VIII. Claim 165, drawn to method of obtaining a shipping status, classified in class 705, subclass 1.

IX. Claims 166, drawn to a computer system, which stores a return record in a database a return record corresponding to a request, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions. Invention I receives and processes returns using policy rules and Invention II saves a three dimensional matrix in for a set of questions.

3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. Invention I the computer system receives and processes return requests, and Invention III displays a set of questions and receives answers to the questions.

4. Inventions I and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has a utility in processing requests and invention IV has separate utility such as receiving rates for shipment. See MPEP § 806.05(d).

5. Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as calculating shipping rates. See MPEP § 806.05(d).

6. Inventions I and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as preparing shipping labels. See MPEP § 806.05(d).

7. Inventions I and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VII has separate utility such as designating a status of a record in a computer system, whereas invention I only processes requests. See MPEP § 806.05(d).

8. Inventions I and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VIII has separate utility such as obtaining a shipping status of a package. See MPEP § 806.05(d).

9. Inventions I and IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IX has separate utility such as storing records in databases. See MPEP § 806.05(d).

10. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as saving data in a specialized format in a computer system, whereas invention III displays data. See MPEP § 806.05(d).

11. Inventions II and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as rating a shipment. See MPEP § 806.05(d).

12. Inventions II and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as calculating rates of a shipment. See MPEP § 806.05(d).

13. Inventions II and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VI has separate utility such as preparing a shipping label. See MPEP § 806.05(d).

14. Inventions II and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VII has separate utility such as designating a status of a record in a system. See MPEP § 806.05(d).

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15. Inventions II and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VIII has separate utility such as obtaining a shipping status. See MPEP § 806.05(d).

16. Inventions II and IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IX has separate utility such as storing records in a database. See MPEP § 806.05(d).

17. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as rating a shipment. See MPEP § 806.05(d).

18. Inventions III and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility such as calculating rates of a shipment. See MPEP § 806.05(d).

19. Inventions III and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VI has separate utility such as preparing a shipping label. See MPEP § 806.05(d).

20. Inventions III and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be

separately usable. In the instant case, invention VII has separate utility such as designating a status of a record in a system. See MPEP § 806.05(d).

21. Inventions III and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VIII has separate utility such as obtaining a shipping status. See MPEP § 806.05(d).

22. Inventions III and IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IX has separate utility such as storing records in a database. See MPEP § 806.05(d).

23. Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operations. Invention V has separate utility such as calculating rates of a shipment, whereas invention IV receives requests for rating a shipment, which does not require the calculation, can merely obtain rates from tables. See MPEP § 806.05(d).

24. Inventions IV and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VI has separate utility such as preparing a shipping label. See MPEP § 806.05(d).

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25. Inventions IV and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VII has separate utility such as designating a status of a record in a system. See MPEP § 806.05(d).

26. Inventions IV and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VIII has separate utility such as obtaining a shipping status. See MPEP § 806.05(d).

27. Inventions II and IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IX has separate utility such as storing records in a database. See MPEP § 806.05(d).

28. Inventions V and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VI has separate utility such as preparing a shipping label. See MPEP § 806.05(d).

29. Inventions V and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VII has separate utility such as designating a status of a record in a system. See MPEP § 806.05(d).

30. Inventions V and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be

separately usable. In the instant case, invention VIII has separate utility such as obtaining a shipping status. See MPEP § 806.05(d).

31. Inventions V and IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IX has separate utility such as storing records in a database. See MPEP § 806.05(d).

32. Inventions VI and VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VII has separate utility such as designating a status of a record in a system. See MPEP § 806.05(d).

33. Inventions VI and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VIII has separate utility such as obtaining a shipping status. See MPEP § 806.05(d).

34. Inventions VI and IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IX has separate utility such as storing records in a database. See MPEP § 806.05(d).

35. Inventions VII and VIII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VIII has separate utility such as obtaining a

shipping status, whereas invention VII has a separate utility such as designating a status of the return record. See MPEP § 806.05(d).

36. Inventions VII and IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IX has separate utility such as storing records in a database. See MPEP § 806.05(d).

37. Inventions VIII and IX are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention VIII has separate utility such as obtaining shipping status for tracking purposes, and invention IX stores a return request in a database, for record keeping purposes. See MPEP § 806.05(d).

38. Because these inventions are distinct for the reasons given above and the search required for each group is not required for all other groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


39. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

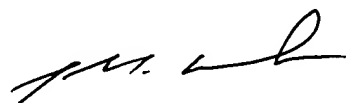
application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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